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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,266	02/24/2004	Douglas A. Collins	07959.105030 (COP 1003 CO	3875
20786	7590	02/23/2005	EXAMINER JONES, DAMERON LEVEST	
KING & SPALDING LLP 191 PEACHTREE STREET, N.E. ATLANTA, GA 30303-1763			ART UNIT 1616	
PAPER NUMBER				

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,266

Applicant(s)

COLLINS ET AL.

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/10/04; 11/26/04; and 2/24/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11,20-27,33-44 and 47-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-11,20-27,33-44 and 47-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/10/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the following:

(a). the amendment filed 2/24/04 wherein the specification was amended; claims 56 and 60 were amended; and claims 63-69 were canceled; and

(b). the amendment filed 11/26/04 wherein claims 2, 3, 12-19, 28-32, 45, 46, and 63-69 are canceled and claims 1, 47-49, and 60 are amended.

Note: Claims 1, 4-11, 20-27, 33-44, and 47-62 are pending.

APPLICANT'S INVENTION

2. Applicant's invention is directed to compounds as set forth in independent claims 1 and 33 and uses thereof.

RESPONSE TO APPLICANT'S ELECTION

3. Applicant's election of the species of claim 1 wherein the peptide residue is poly-L-lysine (8 units); the non-metallic radionuclide is fluorine-18; and X=CN filed 11/26/04 is acknowledged.

Note: Initially, Applicant's elected species was searched. However, since no prior art was found which could be used to reject Applicant's claims, the search was extended over the full scope of the invention.

DOUBLE PATENTING REJECTIONS

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 4-11, 20-27, 33-44, and 47-62 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 15, 16, 19, 21, 23-26, 28-31, and 34-41 of U.S. Patent No. 6,838,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compounds of formula I that is linked to one or more peptide residues or amino acid residues. The claims differ in that in the instant

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invention, the central atom is cobalt and that of the patented invention is copper. It would be obvious to replace the copper with cobalt because claim 15 of the patented invention disclose that the radioisotope may be selected from cobalt or copper in addition to other isotopes. In addition, while patented invention is directed to one or more metallic radionuclides, it would be obvious to use one or more non-metallic radionuclides as set forth in the instant invention because claim 25, for example, in the patented invention is directed to the detectable radionuclide being non-metallic.

112 REJECTIONS

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 26, 27, and 33-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26 and 27: The claim as written is ambiguous because there are too many attachments to the carbon atom (see the [CH₂] group). Thus, since claim 26 is unclear the claims depending thereof, claims 27, is also ambiguous

Claims 33-36: The claim as written is ambiguous because there are too many attachments to the carbon atom (see the [CH₂] group). Thus, since independent claim 33 is unclear the claims depending thereof, claims 34-36, are also ambiguous.

COMMENTS/NOTES

8. For clarity of independent claim 33, Applicant is respectfully requested to insert the structure of formula I into the claim.

9. For clarity of independent claim 1, Applicant is respectfully requested to identify the variables a-g.

10. It should be noted that no prior art has been cited against Applicant's claims. However, Applicant MUST address and overcome the double patenting and 112 rejections above. In particular, the claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious compounds and uses thereof as set forth in independent claims 1 and 33. The closest art is Applicant's own work which is cited in the double patenting rejection above.

COMMENTS/NOTES


11. Applicant is respectfully requested to provide the year of the documents listed on page 5 of information disclosure statement filed 5/10/04 in the next correspondence to the Examiner. Specifically, documents EG and EO need a year of publication.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
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February 18, 2005